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EXAMINER

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3626

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 12

Application Number: 09/544,509  
Filing Date: 06 April 2000  
Appellant(s): WYATT

**MAILED**  
JAN 15 2004  
GROUP 3600

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Brian M. Mattson  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 27 October 2003.

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**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

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**(7) Grouping of Claims**

Appellant's brief includes a statement that claims 1, 15, 2-14, and 16-20 do not stand or fall together, implying four groups. However Appellant's arguments in section VIII of the appeal brief point to twenty separate groupings, one for each claim. Appellant provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

|             |                       |         |
|-------------|-----------------------|---------|
| 6, 022, 315 | Iliff                 | 02-2000 |
| 5, 974, 124 | Schluetter, Jr. et al | 10-1999 |
| 5, 652, 842 | Siegrist, Jr. et al   | 07-1997 |

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-20 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Actions, Papers No. 4 and 7 and reproduced hereinbelow. The rejections which appear below substantially repeat the rejections made in the previous Office Actions (Papers No. 4 and 7). The text of those sections of Title 35 U.S. Code relied upon in the Examiner's Answer is set forth in the previous Office actions, Papers 4 and 7.

*Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-11, 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iliff, U.S. Patent Number 6, 022, 315 in view of Schlueter et al, U.S. Patent Number 5, 974, 124.

(A) As per claim 1, Iliff teaches a method for matching medical condition information with a medical resource (Iliff; column 4, lines 31-35, column 65, lines 2-5), the method comprising the steps of:

providing a computer network having a plurality of remote computers and at least one remote server wherein the remote server hosts a website (Iliff; Abstract, Figure 24, Figure 25a, Figure 28, Item 2359, Figure 30, Item 2102, column 68, lines 45-67, column 69, lines 2-3, 34-63, column 70, lines 15-18, column 74, lines 33-44, column 80, lines 4-9);

accessing the website via an individual remote computer on the computer network (Iliff; column 69, lines 2-5, 44-63, column 70, lines 15-51, column 71, lines 36-51);

providing a database on the remote server wherein the database stores information relating to a plurality of medical conditions (Iliff; Figure 25b, Figure 26, Figure 27, column 75, lines 29-36, 60-65); and

searching the database for the information wherein the search or request is based on the query or search request input into the database and further wherein the search discloses a medical

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resource that treats the medical condition queried (Iliff; Figure 31, Items 2510 and 2546, column 36, lines 9-13, column 60, lines 57-63, column 75, lines 18-28).

Iliff fails to explicitly disclose inputting a query into the website wherein the query relates to a medical condition;

Schlueter teaches inputting a query or request for data into the website wherein the query relates to a medical condition (Schlueter; Abstract, column 4, lines 23-31, column 5, lines 26-28, 40-52);

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method for matching medical condition information with a medical resource of Iliff to include inputting a query into the website wherein the query relates to a medical condition, as taught by Schlueter, with the motivation of more quickly providing accurate records with simple and versatile input and output of information from a centralized data base, thereby hastening the treatment of disease (Schlueter; column 1, line 63 to column 2, line 2).

(B) As per claims 2-3, Iliff and Schlueter teach a method as discussed in claim 1 above, further comprising the step of outputting the information to the individual remote computer (Iliff; Figure 29, Item 2406, column 70, line 39 to column 71, line 3, column 76, lines 51-67) and wherein the medical disorders or conditions relate to diseases (Iliff; column 12, lines 24-27, column 12, line 66 to column 13, line 6, column 20, lines 1-5, column 21, lines 35-39, column 67, lines 60-65).

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(C) As per claims 4-5, Iliff and Schlueter teach a method as discussed in claim 1 above, further comprising the step of providing medical procedure information to one of the computers (Iliff; Figure 29, Items 2406, 2408, 2410, column 12, line 66 to column 13, line 6) and further comprising the step of searching the database for medical procedure information (Iliff; column 57, lines 10-42).

(D) As per claims 6-7, Iliff and Schlueter teach a method as discussed in claim 1 above, further comprising the step of disclosing on one of the remote computers a practitioner or provider that treats the medical condition queried (Iliff; Figure 31, Item 2546, column 36, lines 9-13, column 41, lines 46-48, column 42, lines 17-25, column 54, lines 12-14, column 62, lines 26-37, column 70, line 38 to column 71, line 3, column 75, lines 18-28) and further comprising the step of disclosing to the individual remote computer the medical facility that treats the medical condition queried (Iliff; Figure 31, Item 2546, column 36, lines 9-13, column 41, lines 46-48, column 42, lines 17-25, column 54, lines 12-14, column 62, lines 26-37, column 70, line 38 to column 71, line 3, column 75, lines 18-28).

(E) As per claims 8, 10, Iliff and Schlueter teach a method as discussed in claim 1 above, further comprising the step of disclosing specific medical resource information wherein the specific medical resource information includes a name of the medical resource, a location, contact information and services offered (Iliff; column 42, lines 17-25), and wherein the information discloses a plurality of medical resources that treat the medical condition queried (Iliff; column 42, lines 17-25).

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(F) As per claim 9, Iliff and Schlueter teach a method as discussed in claim 1 above, further comprising the step of linking one of the remote computers to a specific website relating to the medical resource (Iliff; column 69, lines 2-5, 44-63, column 70, lines 15-51, column 71, lines 36-51).

(G) As per claim 11, Iliff and Schlueter teach a method as discussed in claim 1 above, wherein the query includes identifying information of an individual using the website (Iliff; Figure 30, Item 2442, column 79, lines 38-41) wherein search results disclosing medical resources match the identifying information to the medical resource (Iliff; column 42, lines 17-25).

(H) As per claim 13, Iliff and Schlueter teach a method as discussed in claim 1 above, further comprising the step of providing a plurality of websites on the computer network, accessing any one of the plurality of websites via the remote computer, and searching the database via any one of the plurality of websites (Iliff; Figure 28, Figure 30, Item 2102, column 60, lines 57-63, column 69, lines 2-5, 44-63, column 70, lines 15-51, column 71, lines 36-51, column 75, lines 18-28, 29-36, 60-65) (Schlueter; column 1, line 63 to column 2, line 2).

(I) As per claim 14, Iliff and Schlueter teach a method as discussed in claim 1 above, further comprising the step of providing a plurality of databases on a plurality of remote servers wherein the databases store the information relating to the medical conditions, linking the



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databases via the computer network; and searching the databases for the information (Iliff; Figure 25a, Item 2108, Figure 26, Figure 27, Figure 31, Items 2510 and 2546, column 36, lines 9-13, column 60, lines 57-63, column 69, lines 2-5, 44-63, column 70, lines 15-51, column 71, lines 36-51, column 75, lines 18-28, 29-36, 60-65).

(J) Claim 15 differs from claim 1 in that it is a system for matching medical condition information with a medical resource rather than a method for matching medical condition information with a medical resource.

As per claim 15, Iliff and Schlueter teach a system for matching medical condition information with a medical resource, the system comprising:

a computer network having a plurality of remote computers and at least one remote server wherein the remote server hosts a website (Iliff; Abstract, Figure 24, Figure 25a, Figure 28, Item 2359, Figure 30, Item 2102, column 68, lines 45-67, column 69, lines 2-3, 34-63, column 70, lines 15-18, column 74, lines 33-44, column 80, lines 4-9);

a database connected to the remote server wherein the database stores information relating to a plurality of medical conditions (Iliff; Figure 25b, Figure 26, Figure 27, column 75, lines 29-36, 60-65);

means for querying the database wherein the query relates to one of the medical conditions (Iliff; Figure 31, Items 2510 and 2546, column 36, lines 9-13, column 60, lines 57-63, column 75, lines 18-28) (Schlueter; Abstract, column 4, lines 23-31, column 5, lines 26-28, 40-52); and

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means for searching the database for the information wherein the search is based on the query of the database and further wherein the information discloses a medical resource that treats the medical condition queried (Iliff; Figure 31, Items 2510 and 2546, column 36, lines 9-13, column 60, lines 57-63, column 75, lines 18-28).

The motivation for combining Iliff and Schlueter is as discussed in the rejection of claim 1 above, and is incorporated herein.

(K) As per claim 16, Iliff and Schlueter teach a system as discussed in claim 15 above, further comprising means for outputting the information from an individual remote computer (Iliff; Figure 29, Item 2410, column 60, lines 57-67, column 70, line 39 to column 71, line 3, column 76, lines 51-67).

(L) As per claims 17-18, Iliff and Schlueter teach a system as discussed in claim 15 above, wherein the medical conditions or disorders relate to diseases (Iliff; column 12, lines 24-27, column 12, line 66 to column 13, line 6, column 20, lines 1-5, column 21, lines 35-39, column 67, lines 60-65) and wherein the information relating to the medical conditions further relates to medical procedures (Iliff; Figure 29, Items 2406, 2408, 2410, column 12, line 66 to column 13, line 6, column 57, lines 10-42).

(M) As per claim 19, Iliff and Schlueter teach a system as discussed in claim 15 above, wherein the information relates to practitioners that treat the medical condition queried (Iliff; Figure 31, Item 2546, column 36, lines 9-13, column 41, lines 46-48, column 42, lines 17-

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25, column 54, lines 12-14, column 62, lines 26-37, column 70, line 38 to column 71, line 3, column 75, lines 18-28).

(N) As per claim 20, Iliff and Schlueter teach a system as discussed in claim 15 above, further comprising a link on the website wherein the link links one of the remote computers to another website providing further information relating to the medical resource (Iliff; Figure 30, column 68, lines 57-64, column 70, line 39 to column 71, line 3, column 72, lines 3-48, column 74, lines 25-44, column 80, lines 31-34).

3. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iliff, U.S. Patent Number 6, 022, 315 and Schlueter et al, U.S. Patent Number 5, 974, 124 as applied to claim 1 above, and further in view of Siegrist, Jr. et al, U.S. Patent Number 5, 652, 842.

(A) As per claim 12, Iliff and Schlueter teach a computer-implemented method, as analyzed above in claim 1.

Iliff and Schlueter fail to explicitly disclose further comprising the step of disclosing a plurality of medical resources that treat the disorder queried; and ranking or comparing the medical resources based on how the medical resources match the query.

Siegrist teaches the step of disclosing a plurality of medical resources that treat the disorder queried; and ranking or comparing the medical resources based on how the medical resources match the query (Siegrist; column 2, lines 41-54, column 3, line 65 to column 4, line 16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method for matching medical condition information with a medical resource of Iliff and Schlueter to include the step of disclosing a plurality of medical resources that treat the disorder queried; and ranking or comparing the medical resources based on how the medical resources match the query, as taught by Siegrist, with the motivation of allowing users to define parameters on which to compare service providers as well as focusing the attention of the service providers on the most promising opportunities for cost savings, profit improvements, and improved competitive advantage. (Siegrist; column 2, lines 41-46, 56-61, column 3, line 67 to column 4, line 3).

**(11) *Response to Argument***

In the Appeal Brief filed 27 October 2003, Appellant makes the following three arguments:

(A) The applied references, "taken singly or in combination, do not teach or suggest claims 1-11 and 13-20, and it would not have been obvious to combine them by one having ordinary skill in the art at the time of the invention".

(B) The applied references, "taken singly or in combination, do not teach or suggest claim 12, and it would not have been obvious to combine them by one having ordinary skill in the art at the time of the invention".

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(C) The totality of the references in their entireties does not collectively suggest the claimed invention to one of ordinary skill in the art and there is no teaching, suggestion, or incentive in the art to make obvious the combination of the applied references.

Examiner will address Appellant's arguments in sequence as they appear in the brief.

(A) In response to Appellant's assertion that Iliff, or Schlueter, Jr. et al, taken singly or in combination, do not teach or suggest claims 1-11 and 13-20 of Appellant's invention, and that it would not have been obvious to combine them by one having ordinary skill in the art at the time of the invention, all of the limitations which Appellant disputes are missing in the applied references, including searching the database for the information wherein the search is based on the query input into the database and further wherein the search discloses a medical resource that treats the medical condition queried and also including inputting a query into the website wherein the query relates to a medical condition, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of Iliff and Schlueter, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the cited sections of the prior Office Actions (papers number 4 and 7), and as noted above, and incorporated herein. Further reasons appear hereinbelow.

*1. Claim 1:*

In particular, Examiner notes Iliff and Schlueter teach all the limitations of claim 1, including the steps of "inputting a query into the website wherein the query relates to a medical

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condition" and of "searching the database for the information wherein the search or request is based on the query or search request input into the database and further wherein the search discloses a medical resource that treats the medical condition queried." Note, for example that Iliff includes "[I]t is presently possible for a computer to search the world's medical literature daily. Any articles pertaining to a particular topic can automatically be requested and the information used to update the system. In addition, the MDATA system 100 is currently using optical character recognition technology to digitize its medical database. Then, using indexing techniques, the MDATA system 100 is able to search for and retrieve any information desired. For example, the system can search for the character string "headache" and retrieve any amount of surrounding text or graphic information. This information is then collected, collated, printed and referred to the physician(s)..." (Iliff column 60, lines 53-65). Inputting a query into a database is the method by which the information desired is extricated from the mass of data stored in a database. The access and retrieval of information from the database on request, as recited by Iliff, reads on searching the database for the information wherein the search is based on the query input into the database and further wherein the search discloses a medical resource that treats the medical condition queried.

As well, note that Schlueter teaches "[r]equests for data by medical practitioners is transmitted to the primary computer in a manner similar to the transmission of raw data. In response to a request for data, output, in the form of a chart or graph, or multiple charts and graphs, is transmitted to the remote computer for display on the computer screen and/or printed for hard copy, or faxed to the medical practitioner or assistant." Schlueter also teaches "[t]he primary computer 100 is a multi-purpose computer having software and hardware that enable it

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to receive information from the variety of sources mentioned, a microprocessor to process the data, store the data on a mass storage device integrated with the computer 100, and present the raw and processed data when required via output means. Its primary purpose is to receive medical readings over long periods of time, store the information as medical histories in a data base application, and present the information to medical practitioners in a form which facilitates accurate diagnosis and treatment of patients' chronic medical conditions" and "the remote computer, using software commonly referred to as a "web browser," such as Netscape, Mosaic, or Internet Explorer, can access the primary computer 100, which would be set up as a "web server." Remote computer 50 is provided with software enabling automatic access, retrieval, and display of the required information at the request of the user--typically the medical practitioner or assistant" (Schlueter; Abstract, column 4, lines 23-31, column 5, lines 40-52, column 6, lines 14-21). The access, retrieval and display of the required medical information remotely by using a web browser and accessing a web server (which provides or serves the website), as taught by Schlueter reads on inputting a query into the website wherein the query relates to a medical condition.

As such, it is unclear as to how or why Appellant's claimed limitations are not met by at least the aforementioned passages. Perhaps Appellant is relying on features not expressly recited in the claims, but disclosed in the specification. However it has been held that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Consequently, it is respectfully submitted that contrary to Appellant's allegations, the features that Appellant disputes are clearly within the teachings of the applied references and that

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Appellant fails to properly consider the clear and unmistakable teachings of the applied references, as illustrated above.

2. *Claim 15:*

In response to Appellant's assertion that Iliff, or Schlueter, Jr. et al, taken singly or in combination, do not teach or suggest the limitations recited in independent claim 15 of Appellant's invention, and that it would not have been obvious to combine them by one having ordinary skill in the art at the time of the invention, all of the limitations which Appellant disputes are missing in the applied references have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of Iliff and Schlueter, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the cited sections of the prior Office Actions (papers number 4 and 7), and as noted above, and incorporated herein. In particular, Examiner notes Iliff and Schlueter teach a "means for querying the database wherein the query relates to one of the medical conditions" as well as a " means for searching the database for the information wherein the search is based on the query of the database and further wherein the information discloses a medical resource that treats the medical condition queried" Note, for example that Iliff includes "[I]t is presently possible for a computer to search the world's medical literature daily. Any articles pertaining to a particular topic can automatically be requested and the information used to update the system. In addition, the MDATA system 100 is



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currently using optical character recognition technology to digitize its medical database. Then, using indexing techniques, the MDATA system 100 is able to search for and retrieve any information desired. For example, the system can search for the character string "headache" and retrieve any amount of surrounding text or graphic information. This information is then collected, collated, printed and referred to the physician(s)..." (Iloff column 60, lines 53-65). Inputting a query into a database is the method by which the information desired is extricated from the mass of data stored in a database. The access and retrieval of information from the database on request such as the entry of the character string "headache," as recited by Iliff, reads on means for searching the database for the information wherein the search is based on the query input into the database and further wherein the search discloses a medical resource that treats the medical condition queried.

As well, note that Schlueter teaches "[r]equests for data by medical practitioners is transmitted to the primary computer in a manner similar to the transmission of raw data. In response to a request for data, output, in the form of a chart or graph, or multiple charts and graphs, is transmitted to the remote computer for display on the computer screen and/or printed for hard copy, or faxed to the medical practitioner or assistant." Schlueter also teaches "[t]he primary computer 100 is a multi-purpose computer having software and hardware that enable it to receive information from the variety of sources mentioned, a microprocessor to process the data, store the data on a mass storage device integrated with the computer 100, and present the raw and processed data when required via output means. Its primary purpose is to receive medical readings over long periods of time, store the information as medical histories in a data base application, and present the information to medical practitioners in a form which facilitates

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accurate diagnosis and treatment of patients' chronic medical conditions" and "the remote computer, using software commonly referred to as a "web browser," such as Netscape, Mosaic, or Internet Explorer, can access the primary computer 100, which would be set up as a "web server." Remote computer 50 is provided with software enabling automatic access, retrieval, and display of the required information at the request of the user--typically the medical practitioner or assistant" (Schlueter; Abstract, column 4, lines 23-31, column 5, lines 40-52, column 6, lines 14-21). The access, retrieval and display of the required [medical] information remotely by using a web browser and accessing a web server, which provides or serves the website and stores the database of medical information, as taught by Schlueter, reads on means for querying the database wherein the query relates to one of the medical conditions.

As such, it is unclear as to how or why Appellant's claimed limitations are not met by at least the aforementioned passages. Perhaps Appellant is relying on features not expressly recited in the claims, but disclosed in the specification. However it has been held that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Consequently, it is respectfully submitted that contrary to Appellant's allegations, the features that Appellant disputes are clearly within the teachings of the applied references and that Appellant fails to properly consider the clear and unmistakable teachings of the applied references, as illustrated above.

### 3. *Claim 2*

In response to Appellant's assertion that Iliff, or Schlueter, Jr. et al, taken singly or in combination, do not teach or suggest the limitations recited in dependent claim 2 of Appellant's

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invention, the applied references teach a method further comprising the step of outputting the information to the individual remote computer (Iliff, Figure 29, Item 2406, column 70, line 39 to column 71, line 3, column 76, lines 51-67).

4. *Claim 3*

In response to Appellant's assertion that Iliff, or Schlueter, Jr. et al, taken singly or in combination, do not teach or suggest the limitations recited in dependent claim 3 of Appellant's invention, the applied references teach a method wherein the medical disorders or conditions relate to diseases (Iliff, column 12, lines 24-27, column 12, line 66 to column 13, line 6, column 20, lines 1-5, column 21, lines 35-39, column 67, lines 60-65).

5. *Claim 4*

In response to Appellant's assertion that Iliff, or Schlueter, Jr. et al, taken singly or in combination, do not teach or suggest the limitations recited in dependent claim 4 of Appellant's invention, the applied references teach a method further comprising the step of providing medical procedure information to one of the computers (Iliff, Figure 29, Items 2406, 2408, 2410, column 12, line 66 to column 13, line 6).

6. *Claim 5*

In response to Appellant's assertion that Iliff, or Schlueter, Jr. et al, taken singly or in combination, do not teach or suggest the limitations recited in dependent claim 5 of Appellant's

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invention, the applied references teach a method further comprising the step of searching the database for medical procedure information (Iliff; column 57, lines 10-42).

7. *Claim 6*

In response to Appellant's assertion that Iliff, or Schlueter, Jr. et al, taken singly or in combination, do not teach or suggest the limitations recited in dependent claim 6 of Appellant's invention, the applied references teach a method further comprising the step of disclosing on one of the remote computers a practitioner or provider that treats the medical condition queried (Iliff; Figure 31, Item 2546, column 36, lines 9-13, column 41, lines 46-48, column 42, lines 17-25, column 54, lines 12-14, column 62, lines 26-37, column 70, line 38 to column 71, line 3, column 75, lines 18-28).

8. *Claim 7*

In response to Appellant's assertion that Iliff, or Schlueter, Jr. et al, taken singly or in combination, do not teach or suggest the limitations recited in dependent claim 7 of Appellant's invention, the applied references teach a method further comprising the step of disclosing to the individual remote computer the medical facility that treats the medical condition queried (Iliff; Figure 31, Item 2546, column 36, lines 9-13, column 41, lines 46-48, column 42, lines 17-25, column 54, lines 12-14, column 62, lines 26-37, column 70, line 38 to column 71, line 3, column 75, lines 18-28).

9. *Claim 8*

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In response to Appellant's assertion that Iliff, or Schlueter, Jr. et al, taken singly or in combination, do not teach or suggest the limitations recited in dependent claim 8 of Appellant's invention, the applied references teach a method further comprising the step of disclosing specific medical resource information wherein the specific medical resource information includes a name of the medical resource, a location, contact information and services offered (Iliff, column 42, lines 17-25).

*10. Claim 9*

In response to Appellant's assertion that Iliff, or Schlueter, Jr. et al, taken singly or in combination, do not teach or suggest the limitations recited in dependent claim 9 of Appellant's invention, the applied references teach a method further comprising the step of linking one of the remote computers to a specific website relating to the medical resource (Iliff, column 69, lines 2-5, 44-63, column 70, lines 15-51, column 71, lines 36-51)

*11. Claim 10*

In response to Appellant's assertion that Iliff, or Schlueter, Jr. et al, taken singly or in combination, do not teach or suggest the limitations recited in dependent claim 10 of Appellant's invention, the applied references teach a method wherein the information discloses a plurality of medical resources that treat the medical condition queried (Iliff, column 42, lines 17-25).

*12. Claim 11*

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In response to Appellant's assertion that Iliff, or Schlueter, Jr. et al, taken singly or in combination, do not teach or suggest the limitations recited in dependent claim 11 of Appellant's invention, the applied references teach a method wherein the query includes identifying information of an individual using the website (Iliff; Figure 30, Item 2442, column 79, lines 38-41) wherein search results disclosing medical resources match the identifying information to the medical resource (Iliff; column 42, lines 17-25).

*13. Claim 13*

In response to Appellant's assertion that Iliff, or Schlueter, Jr. et al, taken singly or in combination, do not teach or suggest the limitations recited in dependent claim 13 of Appellant's invention, the applied references teach a method further comprising the step of providing a plurality of websites on the computer network, accessing any one of the plurality of websites via the remote computer, and searching the database via any one of the plurality of websites (Iliff; Figure 28, Figure 30, Item 2102, column 60, lines 57-63, column 69, lines 2-5, 44-63, column 70, lines 15-51, column 71, lines 36-51, column 75, lines 18-28, 29-36, 60-65) (Schlueter; column 1, line 63 to column 2, line 2).

*14. Claim 14*

In response to Appellant's assertion that Iliff, or Schlueter, Jr. et al, taken singly or in combination, do not teach or suggest the limitations recited in dependent claim 14 of Appellant's invention, the applied references teach a method further comprising the step of providing a plurality of databases on a plurality of remote servers wherein the databases store the information

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relating to the medical conditions, linking the databases via the computer network; and searching the databases for the information (Iliff, Figure 25a, Item 2108, Figure 26, Figure 27, Figure 31, Items 2510 and 2546, column 36, lines 9-13, column 60, lines 57-63, column 69, lines 2-5, 44-63, column 70, lines 15-51, column 71, lines 36-51, column 75, lines 18-28, 29-36, 60-65).

*15. Claim 15*

In response to Appellant's assertion that Iliff, or Schlueter, Jr. et al, taken singly or in combination, do not teach or suggest the limitations recited in dependent claim 16 of Appellant's invention, the applied references teach a system further comprising means for outputting the information from an individual remote computer (Iliff, Figure 29, Item 2410, column 60, lines 57-67, column 70, line 39 to column 71, line 3, column 76, lines 51-67).

*16. Claim 17*

In response to Appellant's assertion that Iliff, or Schlueter, Jr. et al, taken singly or in combination, do not teach or suggest the limitations recited in dependent claim 17 of Appellant's invention, the applied references teach a system wherein the medical conditions or disorders relate to diseases (Iliff, column 12, lines 24-27, column 12, line 66 to column 13, line 6, column 20, lines 1-5, column 21, lines 35-39, column 67, lines 60-65).

*17. Claim 18*

In response to Appellant's assertion that Iliff, or Schlueter, Jr. et al, taken singly or in combination, do not teach or suggest the limitations recited in dependent claim 18 of Appellant's

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invention, the applied references teach a system wherein the information relating to the medical conditions further relates to medical procedures (Iliff; Figure 29, Items 2406, 2408, 2410, column 12, line 66 to column 13, line 6, column 57, lines 10-42).

*18. Claim 19*

In response to Appellant's assertion that Iliff, or Schlueter, Jr. et al, taken singly or in combination, do not teach or suggest the limitations recited in dependent claim 19 of Appellant's invention, the applied references teach a system wherein the information relates to practitioners that treat the medical condition queried (Iliff; Figure 31, Item 2546, column 36, lines 9-13, column 41, lines 46-48, column 42, lines 17-25, column 54, lines 12-14, column 62, lines 26-37, column 70, line 38 to column 71, line 3, column 75, lines 18-28).

*19. Claim 20*

In response to Appellant's assertion that Iliff, or Schlueter, Jr. et al, taken singly or in combination, do not teach or suggest the limitations recited in dependent claim 20 of Appellant's invention, the applied references teach a system further comprising a link on the website wherein the link links one of the remote computers to another website providing further information relating to the medical resource (Iliff; Figure 30, column 68, lines 57-64, column 70, line 39 to column 71, line 3, column 72, lines 3-48, column 74, lines 25-44, column 80, lines 31-34).

Further, the Examiner is concerned that, aside from merely alleging that certain claimed features are not taught or suggested by the applied references either alone or in



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combination, Appellant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Appellant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references. Also, arguments or conclusions of Attorney cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

(B) In response to Appellant's assertion that the applied references, "taken singly or in combination, do not teach or suggest claim 12, and it would not have been obvious to combine them by one having ordinary skill in the art at the time of the invention", the disputed limitations have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of Iliff, Schlueter and Siegrist, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the cited sections of the prior Office Actions (papers number 4 and 7), and as noted above, and incorporated herein. Further reasons appear hereinbelow.

## 20. Claim 12

In particular, Examiner notes Iliff, Schlueter and Siegrist specifically teach the steps of "disclosing a plurality of medical resources that treat the disorder queried" and "ranking or

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comparing the medical resources based on how the medical resources match the query" recited in claim 12. Note, for example that Siegrist teaches " [t]he information used to compare a service provider to its competitors is determined according to parameters generated by the user. Prior to comparison, data representing the performance of the competitors is adjusted to reflect the clientele of the service provider. This adjustment does not affect the service provider's data. The invention is also able to provide multiple levels of comparison, depending upon the level of detail required by the user" (Siegrist, column 2, lines 41-54). Siegrist also includes " a hospital comparison report is requested. To request a report, a user must enter 104 report request parameters 18 which are used by the computer system 5 to retrieve and manipulate the cost and charge information stored in the database 12. The parameters 18 input by the user determine, for example, which patient groups to compare in which hospitals and, therefore, which of the patient level cost and charge information 12d to retrieve from the database 12. Once the appropriate information has been retrieved, the information is accumulated to create total cost and charge information 20 for the chosen patient groups in the chosen hospitals. Even though the maintenance of cost and charge information for every patient of every hospital in a city (or even the nation) requires an enormous database, retrieval and combination of data according to user-defined parameters eliminates unnecessary manipulation of data irrelevant to the particular report being generated" (Siegrist; column 2, lines 41-54, column 3, line 65 to column 4, line 16). The comparison of medical service providers / hospitals according to parameters (e.g. area of specialty, costs, clientele, etc.) determined by users, as recited by Siegrist, clearly reads disclosing a plurality of medical resources that treat the disorder queried; and ranking or comparing the medical resources based on how the medical resources match the query.

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As such, it is unclear as to how or why Appellant's claimed limitations are not met by at least the aforementioned passages. Perhaps Appellant is relying on features not expressly recited in the claims, but disclosed in the specification. However it has been held that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Consequently, it is respectfully submitted that contrary to Appellant's allegations, the features that Appellant disputes are clearly within the teachings of the applied references and that Appellant fails to properly consider the clear and unmistakable teachings of the applied references, as illustrated above.

(C) In response to Appellant's assertion that the totality of the references in their entireties does not collectively suggest the claimed invention to one of ordinary skill in the art and there is no teaching, suggestion, or incentive in the art to make obvious the combination of the applied references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. Note, for example, in the rejection of claim 1, the motivations for combining the teachings of Iliff and Schlueter is more quickly providing

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accurate records with simple and versatile input and output of information from a centralized data base, thereby hastening the treatment of disease, which comes directly from Schlueter (see column 1, line 63 to column 2, line 2 of Schlueter). As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, it is respectfully submitted that Applicant appears to view the applied references separately and in a vacuum, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

Moreover, Applicant apparently ignores the evidence given by the Examiner, namely, recitations of specific portions of the applied reference, express articulation of the combinations and the motivations for combinations, as well as the scientific and logical reasoning of one skilled in the art at the time of the invention, as given in the prior Office Actions and reiterated in the present Examiner's Answer.

Appellant's arguments seem to indicate that Appellant's invention is merely a combination of old and well-known elements. As specified in the remarks and rebuttals given above, Appellant's arguments apparently fail to appreciate the clear and unmistakable suggestions provided in the prior art of record, and relied upon by the Examiner for motivation to combine such well-known elements of the prior art.

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Moreover, with respect to Appellant's argument that a *prima facie* case of obviousness has not been established and that "Examiner is merely 'piece-mealing' references together," the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence has been presented of corresponding claim elements in the prior art and the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see papers number 4 and 7 and present Office Action) have been expressly articulated.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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Thus, in light of the reasons and responses given above, it is respectfully submitted that a *prima facie* case of obviousness has been clearly established by the Examiner. Rather, it is respectfully submitted that Appellant appears to view the applied references in a vacuum without considering their teachings collectively and in view of the knowledge of average skill in the art.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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